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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,650	02/12/2001	Robert John D'Amato	43170-253692 (05213-0493)	2466

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EXAMINER

BADIO, BARBARA P

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 01/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,650

Applicant(s)

D'AMATO ET AL.

Examiner

Barbara P Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 13-18 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z" is Y and Y is oxygen, classified in class 514, subclass 449+.
 - II. Claims 1, 13-18 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z" is Y and Y is nitrogen, classified in class 514, subclass 277+.
 - III. Claims 1, 13-18 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z" is Y and Y is carbon, classified in class 514, subclass 169+.
 - IV. Claims 2, 18 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z" is Y and Y is oxygen, classified in class 514, subclass 449+.
 - V. Claims 2, 18 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z" is Y and Y is nitrogen, classified in class 514, subclass 277+.
 - VI. Claims 2, 18 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z" is Y and Y is carbon, classified in class 514, subclass 169+.

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- VII. Claims 3, 19 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z is Y and Y is oxygen, classified in class 514, subclass 449+.
- VIII. Claims 3, 19 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z is Y and Y is nitrogen, classified in class 514, subclass 277+.
- IX. Claims 3, 19 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z is Y and Y is carbon, classified in class 514, subclass 169+.
- X. Claims 4, 19 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z is Y and Y is oxygen, classified in class 514, subclass 449+.
- XI. Claims 4, 19 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z is Y and Y is nitrogen, classified in class 514, subclass 277+.
- XII. Claims 4, 19 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown wherein Z is Y and Y is carbon, classified in class 514, subclass 169+.
- XIII. Claims 5, 20 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula, classified in class 514, subclass 506+.

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- XIV. Claims 6, 20 and 24 (in part), drawn to a method for treating a mammalian disease by administering a compound of the formula shown, classified in class 514, subclass 506+.
- XV. Claims 7, 21 and 25 (in part), drawn to a compound of the formula shown wherein Z" is Y and Y is oxygen, classified in class 549, subclass 200+.
- XVI. Claims 7, 21 and 25 (in part), drawn to a compound of the formula shown wherein Z" is Y and Y is nitrogen, classified in class 546, subclass 184+.
- XVII. Claims 7, 21 and 25 (in part), drawn to a compound of the formula shown wherein Z" is Y and Y is carbon, classified in class 552, subclass 500+.
- XVIII. Claims 8, 21 and 25 (in part), drawn to a compound of the formula shown wherein Z" is Y and Y is oxygen, classified in class 549, subclass 200+.
- XIX. Claims 8, 21 and 25 (in part), drawn to a compound of the formula shown wherein Z" is Y and Y is nitrogen, classified in class 546, subclass 184+.
- XX. Claims 8, 21 and 25 (in part), drawn to a compound of the formula shown wherein Z" is Y and Y is carbon, classified in class 552, subclass 500+.
- XXI. Claims 9, 22 and 25 (in part), drawn to a compound of the formula shown wherein Z is Y and Y is oxygen, classified in class 549, subclass 200+.
- XXII. Claims 9, 22 and 25 (in part), drawn to a compound of the formula shown wherein Z is Y and Y is nitrogen, classified in class 546, subclass 184+.
- XXIII. Claims 9, 22 and 25 (in part), drawn to a compound of the formula shown wherein Z is Y and Y is carbon, classified in class 552, subclass 500+.

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XXIV. Claims 10, 22 and 25 (in part), drawn to a compound of the formula shown wherein Z is Y and Y is oxygen, classified in class 549, subclass 200+.

XXV. Claims 10, 22 and 25 (in part), drawn to a compound of the formula shown wherein Z is Y and Y is nitrogen, classified in class 546, subclass 184+.

XXVI. Claims 10, 22 and 25 (in part), drawn to a compound of the formula shown wherein Z is Y and Y is carbon, classified in class 552, subclass 500+.

XXVII. Claims 11, 23 and 25 (in part), drawn to a compound of the formula shown, classified in class 558, subclass 1+.

XXVIII. Claims 12, 23 and 25 (in part), drawn to a compound of the formula shown, classified in class 558, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions XV-XXVIII and I-XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product (see Inventions XV-XXVIII).

3. Inventions I-XIV (XV-XXVIII) are unrelated. Each of Inventions I-XIV is drawn to method of using structurally different compounds of Inventions XV-XXVIII.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, from under the elected Group for search purposes, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 FR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Telephone Inquiry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Barbara P Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
January 24, 2002